



PATENT

Attorney Docket No. P3250 (6675.142)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Robert L. CAMPBELL et al.

Serial No. 09/359,260

Filed: July 22, 1999

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: Group Art Unit: 1631
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: Examiner: Ardin Marschel

For: **METHOD, APPARATUS AND COMPUTER PROGRAM PRODUCTS FOR
FORMULATING CULTURE MEDIA**

RESPONSE TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

This communication is being filed in response to the Restriction Requirement mailed April 21, 2004.

Restriction Requirement

Applicants provisionally elect Group I, claims 76, 83-95 and 128, with traverse. A restriction requirement is proper when (1) the inventions are independent or distinct as claimed; and (2) there is a serious burden on the Examiner. (MPEP §803, emphasis added). It is believed that the examination of all the pending claims, claims 76, 82-95, and 128-134 (Groups I, II, III, IV, and V) together, would not pose a serious burden upon the Examiner.

At the outset, the restriction requirement does not provide a basis as to why Group V, claim 134, is subject to restriction. The comments provided in the action provide that Groups I-IV are unrelated, but does not provide any basis as to why Group V, claim 134, should be restricted from the other groups. "Examiners must provide reasons and/or examples to support conclusions [in a restriction requirement]." MPEP 803. Therefore, at a minimum, applicants contend that Groups I and V should be examined together.

The Examiner restricted Groups I, II, III and IV as being unrelated because these groups allegedly are “different inventions, are drawn to different methods comprising different process steps, and employ different components.” *See* Restriction Requirement at 3. The Examiner relies on MPEP 806.04 as the basis for the restriction. However, that section of MPEP 806.04 states that “[t]wo different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent.” Each of the pending claims, on the other hand, is directed to a method of identifying a peptide with a desired activity having an indicia that satisfies a test requirement. Therefore, all of the claims are directed to the same utility. Moreover, the claims recite the same basic steps defining the core of the invention: constructing a first test peptide characterized by a first and second parameter (which can include identifying initial peptides and selecting a plurality of test peptides as set forth in claim 130); measuring first indicia of a property; determining a relationship between the first parameter, second parameter, and the measured first indicia; calculating an estimated indicia; setting a test requirement; selecting a second test peptide library; measuring the indicia of at least one second test peptide; and identifying at least one second test peptide having an indicia that satisfies the test requirement. Where the claims of an application define the same essential characteristics of an invention, “restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.” MPEP 806.03. Because each of the claims is directed to a method of identifying a peptide using the same basic steps, applicants respectfully submit that examination of these groups together would not place an undue on the examiner.

At the very least, the claims dependent from claim 128 should be examined with claim 128 in Group I because applicants have shown that the steps described in the dependent claims are capable of being used in the claimed method of identifying peptides in claim 128. Specifically, claims 129 and 82 further recite that, in the method of identifying a peptide according to claim 128, a space-filling design may be used to expand the first test peptide library to include the isomers of such peptides. Therefore, these further steps require the practice of the individual steps in independent claim 128. Consequently, claims 129 and 82 of Group II, dependent from claim 128, should be examined with Group I, claims 76, 83-95, and 128.

Reconsideration and examination of Groups I, II, III, IV, and V together is respectfully requested. If the Examiner disagrees, Applicants respectfully request that Groups I, II, and V, or Groups I and V be examined together.

Election of Species

Applicants provisionally elect, with traverse, coverage design as the space-filling design, molecular weight as the whole molecule parameter, hydrophobicity as the sequence-specific parameter, 5 for the length of the peptide (e.g., pentamers), and enhancement or inducement of biological activity as the activity. In Group I, claims 76, 83-86, 88, 90-91, 93, 94, 95, and 128 read on the elected species. In the event that the Examiner examines additional groups of invention with Group I, applicants note that the following claims would read on the elected species:

Group II -- claims 82 and 129

Group III -- claims 130 and 131

Group IV -- claims 132 and 133

Group V -- claim 134

Applicants acknowledge that pursuant to MPEP 803.02, if the members of a Markush group are "sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions." MPEP 803.02. Applicants respectfully contend that an examination of each of the species would not be unduly burdensome on the Examiner. Nevertheless, upon the finding that the elected species is allowable over the prior art, applicants acknowledge that, under MPEP 803.02, examination would be extended to the additional non-elected species.

Conclusion

The Commissioner is hereby authorized to charge any fees that may be required for this Amendment, or credit any overpayment to deposit account no. 08-0219. Applicants do not believe that an extension of time is required. However, in the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time which is required to make this

response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 08-0219.

Respectfully submitted,

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A handwritten signature in cursive script, appearing to read "Maria L. Maebius".

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